

Remarks

35 U.S.C. §101 rejections

In the April 30, 2009 Office Action and May 11, 2010 Examiner's Answer claims 36 – 45, 55 – 65, 67 – 69 and 72 - 74 are rejected under 35 USC §101 for being non statutory. The Assignee respectfully traverses the rejections for non statutory subject matter in three ways. First, by noting that the April 30, 2009 Office Action has failed to establish a *prima facie* case of non-statutory subject matter. Second by noting that there is no statutory basis for the claim rejections as all independent claims transform data regarding an entity that physically exists into a different state or thing. Third by noting that the claim rejections fail under both standards of the APA. Finally, the Assignee notes that claim amendments have obviated the claim rejections.

35 U.S.C. §102 rejections

In the April 30, 2009 Office Action and May 11, 2010 Examiner's Answer claims 46, 48, and 53 - 54 were rejected under 35 USC §102 as being anticipated by Bielinski. The Examiner has cited the Bielinski document as a reference. The Assignee traverses the rejections for anticipation in a number of ways. First, by noting that the claim rejections are not in compliance with the Administrative Procedures Act and are therefore moot. Second, by noting that there is no statutory basis for the claim rejections. Third, by noting that the Office Action has failed to establish a *prima facie* case of anticipation. In particular, the April 30, 2009 Office Action fails to establish a *prima facie* case of anticipation for the rejected claims by: citing a document that does not explicitly or inherently describe one or more limitation for every claim, citing a document that does not have the same level of detail included in the rejected claims, by citing a document that does not arrange the limitations in the same way they are arranged in the rejected claims and by citing a document that describes an invention that would require substantial experimentation to match the functionality of the claimed invention. As summarized in previously filed declarations, the cited document provides substantial evidence of the novelty, non-obviousness and newness of the claimed invention. Furthermore, the claim rejections are moot because claim amendments are believed to have obviated these rejections.

35 U.S.C. § 103 Rejection of Claims

In the April 30, 2009 Office Action and May 11, 2010 Examiner's Answer claims 36 – 39, 41 – 43, 45, 47, 55 and 58 - 63 are rejected under 35 USC §103 as being unpatentable over Bielinski alone or in view of Baur. The Examiner has cited these two documents as references. In the April 30, 2009 Office Action, claims 40, 44, 56 and 57 are rejected under 35 USC §103 as being

unpatentable over Bielinski in view of Baur and: Bigus (claim 40), Davis (claim 44), Mauboussin (claim 56) and Davis (claim 57). The Assignee respectfully traverses the §103 rejections of claims 36 –45, 47, 55 and 56 - 63 in several ways. First, by noting that there is no statutory basis for the claim rejections. Second, by noting that the assertions regarding the alleged obviousness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. Finally, by noting that the cited combination of documents fails to establish a *prima facie* case of obviousness. The April 30, 2009 Office Action fails to establish the required *prima facie* case of obviousness in a number of ways, including: by: citing combinations of documents that teach away from the claimed invention, citing a combination of documents that fails to teach one or more limitation for every claim, failing to explain the combination as required by KSR v Teleflex, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function.

In the April 30, 2009 Office Action, claims 49, 50, 51 and 52 are rejected under 35 USC §103 as being unpatentable over Bielinski and Mauboussin (claim 49, 51 and 52) and Stork (claim 50). The Examiner has cited these three documents as references. The Assignee respectfully traverses the §103 rejections of claims 49, 50, 51 and 52 in several ways. First, by noting that there is no statutory basis for the claim rejections. Second, by noting that the assertions regarding the alleged obviousness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. Finally, by noting that the cited combination of documents fails to establish a *prima facie* case of obviousness. The April 30, 2009 Office Action fails to establish the required *prima facie* case of obviousness in a number of ways, including: by: citing combinations of documents that teach away from the claimed invention as discussed on pages 11 through 17 of this paper, citing a combination of documents that fails to teach one or more limitation for every claim as discussed on pages 11 through 17 of this paper, failing to explain the combination as required by KSR v Teleflex, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function.

In the April 30, 2009 Office Action, claims 72 - 75 are rejected under 35 USC §103 as being unpatentable over Bielinski in view of Baur and Lyons. The Examiner has cited these three documents as references. The Assignee respectfully traverses the §103 rejections of claims 72 - 75 in several ways. First, by noting that there is no statutory basis for the claim rejections. Second, by noting that the assertions regarding the alleged obviousness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot.

Finally, by noting that the cited combination of documents fails to establish a prima facie case of obviousness. The April 30, 2009 Office Action fails to establish the required prima facie case of obviousness in a number of ways, including: citing combinations of documents that teach away from the claimed invention, citing a combination of documents that fails to teach one or more limitation for every claim, failing to explain the combination as required by KSR v Teleflex, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function.

In the April 30, 2009 Office Action, claims 64 – 65 and 67 - 69 are rejected under 35 USC §103 as being unpatentable over Davis given Bielinski. The Examiner has cited these documents as references. The Assignee respectfully traverses the §103 rejections of claims 64 – 65 and 67 – 69 in several ways. First, by noting that there is no statutory basis for the claim rejections. Second, by noting that the assertions regarding the alleged obviousness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. Finally, by noting that the cited combination of documents fails to establish a prima facie case of obviousness. The April 30, 2009 Office Action fails to establish the required prima facie case of obviousness in a number of ways, including: citing combinations of documents that teach away from the claimed invention of this paper, citing a combination of documents that fails to teach one or more limitation for every claim, failing to explain the combination as required by KSR v Teleflex, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function.

35 U.S.C. §112 first paragraph rejections

In the April 30, 2009 Office Action and May 11, 2010 Examiner's Answer claims 64 - 65 and 67 - 69 are rejected under 35 USC §112 first paragraph. The Assignee traverses the claim rejections by noting that the evidence required to support the prima facie case that would sustain the claim rejections has not been provided. *"A description as filed is presumed to be adequate; unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. Wertheim, 541 F.2d*

at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

- (A) Identify the claim limitation at issue; and
- (B) Establish a *prima facie case* by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description."

The arguments presented in the November 12, 2008 Office Action fail to establish the *prima facie case* required to sustain a §112 first paragraph rejection for a single claim in at least four ways:

1. No new matter has been introduced. The specification describes a process for developing an application database that comprises an integrated database. The integrated, application database comprises the output of the process. As such, the specification describes the development and output of an integrated database and no new matter has been introduced. Furthermore, U.S. Patent 5,615,109 which is incorporated by reference also describes the development of an integrated database.
2. No experimentation is required. It is well established that "the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). More recently in Invitrogen Corp. v. Clontech Labs, Inc., 429 F.3d 1052, 1058 (Fed. Cir. 2005), the Court referenced Engel Industries, Inc. v. Lockformer Co. 946 F.2d 1528 (Fed. Cir. 1991) and concluded that "the enablement requirement is met if the description enables any mode of making and using the claimed invention". The specification describes the development of a database for a physical object – an organization. The Examiner has not identified any reason why this description can not be used to develop and output a database for any physical object or substance.
3. The use of a term in a claim that is not used in the specification is not a statutory basis for rejection.

35 U.S.C. §112 second paragraph rejections

In the April 30, 2009 Office Action and May 11, 2010 Examiner's Answer claims 55 – 63 are rejected under 35 USC §112 second paragraph. The Assignee notes that the claim rejections are non-statutory, arbitrary and capricious and based on at least one incorrect conclusory statement. Furthermore, these claim rejections are moot because claim amendments have

obviated these rejections.

Copending applications

Under the provisions of MPEP § 2001.06(b), the Examiner is hereby advised of information obtained from co-pending U.S. Patent Application(s) which may be "material to patentability" of the instant application (see Armour & Co. v. Swift & Co., 466 F.2d 767, 779, 175 USPQ 70, 79 7th Cir. 1972).

A review of co-pending applications has revealed that the apparently routine allowance and issue of patents to large companies for "inventions" that do not appear to meet the requirements for allowance (i.e. novelty, written description, etc.) appears to be having a material, negative impact on the prosecution of the assignee's patent applications. In accordance with the prevailing statutes, the allowance and issue of patents to large companies for inventions that do not appear to meet the requirements for allowance should not have any impact on the prosecution of Asset Trust patent applications. In fact, the U.S.P.T.O. has a professed commitment and a legal obligation to invalidate patents that do not meet the legal requirements for patentability. Unfortunately, the U.S.P.T.O. appears to be shielding the patents issued to large companies for "inventions" that do not appear to meet the statutory requirements for allowance instead of honoring their statutory obligation to invalidate them. In particular, the Assignee has recently determined that the primary reasons it has been forced to file over twenty appeals all appear to be related to efforts to bolster patents issued to large companies for inventions that do not appear to be novel. These reasons include:

- 1) the need to traverse apparent misrepresentations that prior art that should properly be used to prevent the allowance of (or invalidate) one or more patents issued to a large company is relevant to an Asset Trust patent application. This is the single largest reason the Assignee has been forced to file so many appeals. For example, one reference used to support claim rejections in co-pending application 11/262,146 was SEAL. Among other things SEAL teaches the use of a "semantic similarity measure" for identifying relevant information. As detailed in prior communications, this teaches away from the claimed invention that relies on a mission oriented context model. Of note is the fact that SEAL was not cited during the prosecution of U.S. Patent 7,644,047 which relies on semantic similarity measures for identifying relevant information. In a similar manner, the primary reference used to support the rejection of the claims in co-pending application 11/262,146 is Cheverst (aka GUIDE). A comparison on the key features of Cheverst to the features of the invention claimed in co-

pending application 11/262,146 and the features of the invention claimed in U.S. Patent 7,474,960 shows that Cheverst appears to be a much closer match to the issued patent than it is to the rejected claims in the co-pending application.

Feature	Cheverst/GUIDE	7,474,960	11/262,146
Primary device	Mobile device	Vehicle with computing device	Personal computer
Primary application	Identify the best route for touring a city for a given location, weather and interests, has a map option	Identify the best route for a given context in a context map	Develop a context model and use it to identify actions that optimize an enterprise performance
Context information	Location, user interests, weather	Location, points of interest, geography	Physical (location, amount), social environment, tactical, instant, organization, mission
Context model created?	No	No	Yes
Data sources	Wireless network, Internet	Wireless networks, Internet, vehicle orientation processor	Enterprise applications, Internet
SW architecture	Client server	Client server	Layered, client server

This practice appears to have been utilized in the instant application as a number of issued patents (i.e. Davis, 6,732,095) appear to be much closer to the references cited during the prosecution of the instant application than they are to the claimed invention.

- 2) the need to traverse apparent misrepresentations that one or more patents issued to a large company for an "invention" that does not appear to meet the requirements for patentability is relevant to an Asset Trust patent application. This practice appears to have been relied upon during the prosecution of the instant application as it is unlikely that the reference, Davis, would have issued if Ranger and Bowman-Amuah been properly considered during prosecution.
- 3) the need to traverse rejections apparently made without explanation that inventions similar or identical to those found in patents issued to large companies represent non-statutory subject matter. As detailed in prior communications, this clearly applies to the instant application.
- 4) the apparently improper use of Official Notice. As noted above, this practice has been relied upon to reject the claims in the instant application.

5. the need to traverse rejections apparently made without evidence that methods and/or claims similar or identical to those found in patents issued to large companies are "too subjective" and/or not enabled. As noted above, this practice has been relied upon to reject the claims in the instant application.
6. the need to traverse rejections made for informalities.

The subject matter contained in the discussion above may be deemed to relate to the present application, and thus may be felt (with or without reasonable justification) to be material to the prosecution of this instant application.

- Copies of cited U.S. patent application(s) (office actions, specification, claims, and the drawings) or copies of the portion(s) of the application(s) which caused it(them) to be cited, including any claims directed to such portion(s) are attached hereto.
- Copies of the cited U.S. Patent Application(s) (office actions, specification, claims, and the drawings) and U.S. Patents are available on the U.S.P.T.O.'s Image File Wrapper. Therefore copies thereof need not be attached.
- The materials in the envelope are considered trade secrets and are being submitted for consideration under MPEP § 724.

The above-listed co-pending application(s) is not to be construed as prior art. By bringing the above-listed application(s) to the attention of the Examiner, the Assignee does NOT waive any confidentiality concerning the above-listed co-pending application(s) or this application. See MPEP §101. Furthermore, if said application(s) should not mature into patents, such application(s) should be preserved in secrecy under the provisions of 35 U.S.C. § 122 and 37 C.F.R. § 1.14.

Acknowledgement

The Assignee previously requested: an unbiased patent application examination conducted by an Examiner with knowledge of the relevant arts who follows the law for the instant application. The Office's apparent failure to provide such an examination for the instant application is taken as an acknowledgment that no personnel with the requisite level of skill in the art and/or training in the relevant statutes and precedents are available at the present time.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons a few claims was amended was to inadvertent correct clerical errors and to put the claims into final form for allowance and issue.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,

Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President
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